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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/720,092	09/27/1996	ROBERT E. KAHN	06154/008001	1226

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FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON, MA 02110

EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2126

DATE MAILED: 01/30/2004

41

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/720,092

Applicant(s)

KAHN ET AL.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-19 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-17 and 24-28 is/are allowed.
- 6) ☐ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Response to Amendment

Response to arguments (independent claim 18)

- Applicant argues that the Markoff reference "makes no reference, either direct or implied, to types of information let alone to the use of a name to refer to a type" [paper #40, page 7, 1st paragraph].

Examiner's response:

The Examiner submits that the phonebook addresses disclosed by Markoff do constitute the use of a name (i.e., address) within the name space (i.e., the phonebook address list) that uniquely identifies types of information (i.e., inherently associated information, such as user names, e-mail addresses and the like, as would necessarily be listed in a phonebook) to be interchanged as part of the communication.

Applicant's arguments, filed Jan. 15, 2004 (paper #40), have been fully considered but they are not deemed to be persuasive with respect to claims 18 & 19. The rejections set forth in the last office action are maintained for claims 18 and 19.

Allowable subject matter

Claims 2-17, 24 - 28 appear to be allowable over the prior art of record in light of Applicant's amendments and supporting arguments of record, subject to the results of a final search.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 18 & 19 are rejected under 35 U.S.C. § 103 as being unpatentable over Antes, Gary M., "Let your 'knowbots' do the walking," Computerworld, May 13, 1991, pp(2), in view of Steinberg, Don, "Demon knowbots (intelligent software robots)," PC-Computing, v3, n1, pp(4), Jan, 1990, and further in view of Markoff, John, "The staggering scope of the Internet: a thicket of networks wound 'round the globe", Digital Media, v1, n11, p19(5) April 20, 1992.

As per independent claim 18:

Andtes, as modified by **Steinberg**, teaches the invention substantially as claimed.

Antes, as modified by **Steinberg**, teaches a method for aiding communication with a mobile program executing in operating environments provided at nodes of a distributed system (as discussed above in the rejection of claim 1 as set forth in the last office action (paper #38, mailed July 11, 2003)).

However, **Antes & Steinberg** do not *explicitly* disclose the following additional limitations:

Markoff teaches maintaining a name space [e.g., '**a variety of Internet "phonebooks"**] that uniquely identifies [i.e., using an **address** and inherent associated name] types of information to be interchanged as part of the communication; and using a name [i.e., an address which can be construed as a unique identifying address or "name" in its own right, or an address that is inherently associated with a name, such as a name found within a phonebook that is comprised of types or categories of listings] within the name space to identify a type of information to be interchanged [p. 4].

See Markoff page 4, lines 26-34:

"Agents for browsing and retrieval. In the future, some computer scientists believe that it will be possible to devise software programs called "agents " that will automatically roam the Internet, browsing for information and retrieving it when it matches an owner's needs. One such agent - "knowledge robot" (Knowbot) - already exists. Vincent Cerf, now a researcher at the Corporation for National Research Initiatives, has designed a program that systematically searches a **variety of Internet "phonebooks"** for an **address** and then mails back the information when it finds a match."

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon the combined system taught by **Antes & Steinberg** by implementing the

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improvements detailed above because it would provide their system with the enhanced capability of using address listings (i.e., internet phonebooks) to browse the internet and find matching information the user is searching for [Markoff p. 4].

As per claim 19:

Antes, as modified by **Steinberg** and **Markoff**, teaches the mobile program registers an interface [i.e., internet phonebook, p. 4] which includes the name of a type of information that is to be interchanged [e.g., **Markoff** discloses the use of an address which can be construed as a unique identifying address or "name" in its own right, or an address that is inherently associated with a name, such as a name found within a phonebook that is typically comprised of "residence" name listings and "business" name listings - page 4].

THIS ACTION IS MADE FINAL.

Applicant is reminded of the extension of time policy as set forth in **37 CFR 1.136(a)**.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to **37 CFR 1.136(a)** will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **St. John Courtenay III** whose voice telephone number is **(703) 308-5217**. A voice mail service is also available at this number. Normal Flex work schedule: M – F 7:30 AM - 4:00 PM

- **All responses sent by U.S. Mail should be mailed to:**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Patent Customers advised to FAX communications to the USPTO

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:


**NEW PTO CENTRAL FAX NUMBER:
703-872-9306**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900**.

Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:

Technical Center 2100 CUSTOMER SERVICE: 703 306-5631

The Manual of Patent Examining Procedure (MPEP) is available online at:
<http://www.uspto.gov/web/offices/pac/mpep/index.html>


**ST. JOHN COURTENAY III
PRIMARY EXAMINER**